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10/657,397	09/08/2003	Robert H. Montgomery JR.	K-1775D	9914

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EXAMINER

SINGH, SUNIL

ART UNIT	PAPER NUMBER
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3673

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/657,397  
Filing Date: September 08, 2003  
Appellant(s): MONTGOMERY, ROBERT H.

Stephen T. Belsheim  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 25, 2005 appealing from the Office action mailed January 19, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

5,683,143     Peterson et al.     11/1997

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims: 22-25.

Claims 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson et al. '143.

Peterson et al. discloses a protective wear sleeve (35) comprising an elongate body having an axial forward end and an axial rearward end; the elongate body having a solid enlarged diameter portion (37) adjacent to the axial forward end thereof and a split portion (51) beginning at and extending in an axial forward direction from the rearward end wherein the split portion contains a slot so that the split portion is flexible in a radial direction, and a solid intermediate portion being between and contiguous with the enlarged diameter portion and the split portion; the split portion having an external surface that is uniform over the entire length thereof and the intermediate portion having an external surface that is uniform wherein the diameter of the external surface of the split portion is equal to the diameter of the surface of the intermediate portion (see Fig. 4). (Re claim 23), the split portion extends for less than one-half of the axial length of the elongate body (see Fig. 4). (Re claim 24), the enlarged diameter

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portion comprises a collar (see Fig. 4). (Re claim 25), the elongate body has a generally cylindrical geometry (see Fig. 4).

### **(10) Response to Argument**

Issue 1: Whether claims 22-25 are patentable under 35 U.S.C. 102(b) over Peterson et al. '143.

Appellant argues that Peterson et al. pertains to a device used to treat floors and not a, "... protective wear sleeve for a bit holder of a cutting tool assembly wherein the bit holder contains a central bore ...". It is explicitly clear that appellant claims are directed to the subcombination of a "protective wear sleeve"; that being said, "for a bit holder of a cutting tool assembly wherein the bit holder contains a central bore" is the intended use of the sleeve. There is no structure called for in appellant's claims that is any different from the sleeve structure disclosed by Peterson et al. (see Fig. 4 and above discussion under "grounds of rejection"). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Appellant further argues that the preamble recitation in claim 22 gives life and meaning to the claim in light of the later recitation that "... when the wear sleeve is in the

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central bore, the external surface of the split portion is biased in a radial outward direction against the central bore of the bit holder so as to retain the wear sleeve in the central bore of the bit holder". Even though the later recitation of "... when the wear sleeve is in the central bore, the external surface of the split portion is biased in a radial outward direction against the central bore of the bit holder so as to retain the wear sleeve in the central bore of the bit holder" breathes life and meaning to the claim, the fact remains that such phrase is still intended use. Appellant is not positively claiming the sleeve in combination with the bit holder; instead, appellant claims are directed explicitly to the subcombination of a "protective wear sleeve". There is no structure called for in appellant's claims that is any different from the sleeve structure disclosed by Peterson et al. (see Fig. 4 and see above discussion under "grounds of rejection"). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Appellant argues that the sleeve of Peterson et al. does not meet the recitation that "the external surface of the split portion is biased in a radial outward direction" when the wear sleeve is in the central bore of the bit holder. It should be noted that appellant is relying on the structure of the bore of the bit holder, which is not positively claimed but merely functionally recited, to affect the structure of the sleeve to meet the limitation

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"biased in a radial outward direction". Simply put, if appellants sleeve were lying on the kitchen table would it then meet the limitation "biased in a radial outward direction"?

The answer is an emphatic no. Therefore, the sleeve of Peterson et al. if placed in a bore of a bit holder wherein the bore is slightly smaller than the diameter of the sleeve the sleeve would compress slightly because of the slot (51) and once it does not pass it's elastic stage (meaning not compress until there is plastic deformation) it would inherently then rebound thus meeting the limitation of "biased in a radial outward direction".

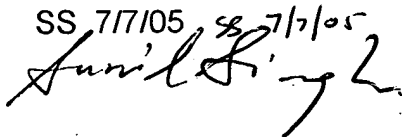
To reiterate examiner's position, there is no structure called for in appellant's claims that is any different from the sleeve structure disclosed by Peterson et al. (see Fig. 4). Therefore any intended use of appellant's sleeve would also be satisfied by Peterson et al. sleeve (35). With regards to the "biased in a radial outward direction", such limitation is met when the sleeve has a slot and is placed in a bore of a bit holder with the diameter of the bore being smaller than the diameter of the sleeve. Since appellant claims never positively call for a bit holder with a bore, the only limitation needed to be met is a sleeve with a slot therein and as depicted in Figure 4 of Peterson et al. such sleeve is shown. Once Peterson et al. sleeve is placed in a bore of a bit holder wherein the bore is slightly smaller than the diameter of the sleeve the sleeve would compress slightly because of the slot (51) and once it does not pass it's elastic stage (meaning not compress until there is plastic deformation) it would inherently then rebound thus meeting the limitation of "biased in a radial outward direction".

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Finally, appellant fails to show how appellant's sleeve structurally differs from the sleeve disclosed by Peterson et al. Therefore, inasmuch appellants sleeve can function as a protective wear sleeve for a bit holder and can be biased in a radial outward direction then so can the sleeve disclosed by Peterson et al. since there is no structure called for in appellants claims that is any different from the sleeve structure disclosed by Peterson et al. (see Fig. 4 and see above discussion under "grounds of rejection").

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

SS 7/7/05 <sup>SS 7/7/05</sup>  


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